

REMARKS

The examiner has rejected claims 4-7 and 9-12 for the reasons stated below. The examiner has objected to claims 8 and 13 as being dependent on a rejected base claim but has indicated that these claims define allowable subject matter. Claims 1-3 were canceled previously.

Applicant has canceled claims 4, 8 and 13 and added new claims 14-19. Applicant traverses the rejections of claims 5-7 and 9-12 for the reasons stated below.

**A. 35 U.S.C. § 102(b)**

The examiner has rejected claims 4-7 and 9-12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,457,898 to Fortin *et al.* ("Fortin *et al.*").

The examiner has stated that Fortin *et al.* discloses a shoe comprising a sole 12, a toe cap 15, an upper 14, and a metatarsal guard 11 with a convex arch portion, a single right and complementary left leg in contact with the sole, a lip 16 overlapping the toe cap, and a section immediately rearward of the support legs that does not bear against the sole. For the purpose of this claim rejection, the examiner has construed the rearward portion of each leg to be a single leg, with the forward portion comprising a forward brace or support.

A proper claim rejection under 35 U.S.C. §102(b) requires that each and every element of the claimed invention be shown or taught in the cited reference. It does not appear that this requirement has been met with respect to claims 5-7 and 9-12. Each of claims 5-7 and 9-12 is dependent on claim 14. The claim rejection is improper if the cited reference does not show or teach each and every element of claim 14.

Even if the examiner's were correct in construing Fortin *et al.* to have single left and right legs, the portion of the Fortin metatarsal guard over a wearer's instep comprises a lower layer comprising a plurality of longitudinal slits 20 that define a plurality of tongues 21. The central tongue 21' comprises an extension that forms flap 22, which is folded at its distal end to cover the top surface of the tongues 21. [Col. 3, lines 29-36; Fig. 1.] Nothing in Fortin shows or teaches a convex arch portion comprising a single layer over a wearer's instep. To the contrary, Fortin *et al.* teaches that flap 22 is required to distribute the load on tongues 21 upon impact by a falling object; it compensates for the weakness of the tongues 21 while allowing movement of the tongues 21 in response to movement of a wearer's foot. [Col. 3, lines 29-30 and 39-41.]

The examiner has stated that Fortin *et al.* discloses left and right support legs that include a section immediately rearward of the legs that does not bear against the sole, such as at the location of the arrow from reference number 10 in Fig. 2. However, this section rearward of the legs appears to be an extension of the legs rather than a part of the convex arch portion corresponding to a wearer's instep. Applicant find nothing in Fortin *et al.* that shows or teaches an integrally molded section of the convex arch portion rearward of the right and left support legs; the upper end of the legs of Fortin *et al.* appears to be contiguous with the convex arch portion.

Fortin *et al.* does not show or teach each and every limitation of claims 5-7 and 9-12, at least for the reasons stated above. Because Fortin *et al.* does not anticipate these claims, applicant requests that this ground for claim rejection be withdrawn.

**B. 35 U.S.C. § 103(a)**

The examiner also has rejected claims 4-7 and 9-12 under 35 U.S.C. § 103(a) as being obvious in view of Fortin *et al.* The examiner has stated that if applicant argues that the guard of Fortin *et al.* has multiple legs, it would have been obvious to remove the flexibility element, slit 19, from each leg to provide a stronger, stiffer guard or that it would have been obvious to remove the leg element forward of the slit 19 to provide a lighter weight guard. The examiner also has stated, without further explanation, that it would have been obvious to remove the flexibility elements, slits 20, from the rear portion of the metatarsal guard 10.

As explained further above, Fortin *et al.* does not show or teach either a convex arch portion comprising a single layer over a wearer's instep or an integrally molded section of the convex arch portion rearward of the right and left support legs. Removal of the flexibility elements and/or the leg element forward of the slit 19 does not result in the claimed invention.

Even if Fortin *et al.* would result in the claimed invention upon removal of or changes to a large number of elements, the number of elements to be removed or changed far exceeds any plausible obviousness argument. In addition, the requisite combination of elements to be removed or changed is apparent only with the benefit of hindsight. The examiner has provided no motivation for removing or changing this particular combination of elements.

Further, the claimed invention provides a simpler, lighter weight metatarsal guard than Fortin *et al.* while maintaining protection and flexibility. The claimed metatarsal guard would appear to be easier and less expensive to produce because less material is required and complex manufacturing steps such as cuts 19, 20 and bending to cause flap 22 to overlay tongues 21 are eliminated. If the claimed combination of elements were obvious, applicant respectfully submits

that Fortin *et al.* would not have chosen such complex means for providing flexibility in its metatarsal guard.

For the reasons stated above, the invention of claims 5-7 and 9-12 is not obvious in view of Fortin *et al.* Accordingly, applicant requests that this ground for claim rejection be withdrawn.

**C. Claim objections**

The examiner has objected to claims 8 and 13 as being dependent on a rejected base claim but has indicated that these claims define allowable subject matter. Applicant has canceled claims 8 and 13. Applicant respectfully submits that claim 18 includes all of the limitations of claim 8 including all of the limitations of the base claim and any intervening claims and claim 19 includes all of the limitations of claim 13 including all of the limitations of the base claim and any intervening claims.

**D. New Claims**

Claims 15 and 16 are dependent on Claim 14. Applicant respectfully submits that claims 15 and 16 are patentable over the cited reference at least for the reasons stated above with respect to claim 15.

Claim 17 requires, among other things, that the support legs have a width less than the width of the convex arch portion between the upper ends of the support legs. Applicant submits that Fortin *et al.* does not show or teach this claim limitation and is patentable over the cited reference at least for this reason.

Claims 18 and 19 include all of the limitations of claims 8 and 13, respectively. As stated above, the allowability of these claims has previously been indicated.

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### CONCLUSION

Applicant respectfully submits that all of the claims presented herein satisfy the statutory requirements for patentability and are patentable over the cited reference. Accordingly, applicant submits that the claims are in condition for allowance and requests that a Notice of Allowance be issued.

Respectfully submitted,

Date: October 25, 2005

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